



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,486	06/28/2001	Uwe D'Agnone		3163

7590 08/19/2003

David R. Schaffer
DILLER, RAMIK & WIGHT
Suite 101
7345 McWhorter Place
Annandale, VA 22003

EXAMINER

PARSLEY, DAVID J

ART UNIT

PAPER NUMBER

3643

DATE MAILED: 08/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicant(s) N .

09/892,486

Applicant(s)

D'AGNONE ET AL.

Examiner

David J Parsley

Art Unit

3643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-32 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 10-32 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 July 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Detailed Action

Amendment

1. This office action is in response to applicant's amendment (paper no. 14) dated 6-26-03 and this action is final.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 10 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Both claims 10 and 28 state that the major opposing surface area portions are devoid of germination seeds therebetween, but than state the germinative seed is removed from the major opposing surface area portions. Therefore it is unclear to whether the seeds as claimed are between the major opposing surface area portions or not.

Claims 11-27 and 29-32 depend from rejected claims 10 and 28 and include all of the limitations of claims 10 and 28 thereby rendering these dependent claims indefinite.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 10-14, 16, 20, and 22-25 are rejected under 35 U.S.C. 102(b) as being anticipated by DE Patent No. 3834812 to Baumli.

Referring to claim 10, Baumli discloses a paper product comprising first and second paper sheets each having first and second opposite paper surfaces with the first paper surfaces being in substantially planar contiguous surface-to-surface opposing relationship at both major – 6 and minor – 17 opposing surface area portions thereof, the major and minor opposing surface area portions of the first and second paper sheets first paper surfaces being adhesively bonded to each other, a line of perforations – 3 in the first and second paper sheets which is adapted to be torn to facilitate the separation of the major – 6 and minor – 1 opposing surface area portions from each other, the major opposing surface area portions being devoid of germination seeds therebetween, and a germinative seed – S housed between the minor opposing surface area portions which minor opposing surface area portions and the germinative seed housed therein can be entirely bodily removed as a plantable unit from the major opposing surface area portions along the lines of perforations for subsequent planting absent adversely affecting damaging or destroying the major opposing surface area portions – see for example figures 1-4 and columns 1-3.

Referring to claim 11, Baumli discloses the line of perforations – 8 is a substantially continuous line of perforations – see for example figures 1-4.

Referring to claims 12 and 23, Baumli discloses the line of perforations has opposite ends – see for example figures 1-4.

Referring to claims 13 and 24, Baumli discloses the line of perforations extend substantially between edges of the sheets – see for example figures 1-4.

Referring to claims 14 and 25 Baumli as seen in figures 1-3 does disclose the line of perforations – at 3, extends substantially between opposite edges of the sheets.

Referring to claim 16, Baumli discloses the minor opposing surface area portions – 1 of the first and second paper sheets first paper surfaces are adhesively bonded to each other – see for example figures 1-4 where the minor opposing surface area portions are adhesively bonded to one another along the side and bottom portions of the packet.

Referring to claim 20, Baumli discloses the major opposing surface area portion provides means for defining an inscription field – see for example figures 1-6 and columns 1-3.

Referring to claim 22, Baumli discloses the line of perforations – at 3 is a substantially continuous line of perforations – see for example figures 1-4.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

Art Unit: 3643

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 15 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baumli as applied to claims 10 and 16 above, and further in view of U.S. Patent No. 4,027,340 to Hadtke. Hadtke does disclose the line of perforations – 22 and 24 is a substantially continuous closed line of perforations – see for example figure 1. Therefore it would have been obvious to one of ordinary skill in the art to take the paper product of Baumli and add the line of perforations being a closed continuous line of Hadtke, so as to allow for the perforated section to be removed from the paper product while not damaging the non-perforated portion of the paper product.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baumli as applied to claim 10 above, and further in view of U.S. Patent No. 5,860,245 to Welch. Baumli further discloses that an adhesive bonds the major opposing surface area portions to each other – see for example figures 1-4. Baumli does not disclose the adhesive is decomposable. Welch does disclose the adhesive is decomposable – see column 3 lines 3-10. Therefore it would have been obvious to one of ordinary skill in the art to take the paper product of Baumli and add the decomposable adhesive of Welch, so as to make the paper product more effective in promoting the plant seed to grow since the adhesive is decomposable and environmentally friendly and thus won't harm the growth of the seed into a plant.

Claims 18 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baumli as applied to claims 10 and 16 above, and further in view of U.S. Patent No. 4,168,002 to Crosby. Baumli does not disclose a means for indicating the presence of the germinative seed between the minor opposing surface area portions. Crosby does disclose a means – see column 3

Art Unit: 3643

lines 44-52 for indicating the presence of the germinative seed between the minor opposing surface area portions – 17 and 18. Therefore it would have been obvious to one of ordinary skill in the art to take the paper product of Baumli and add the means for indicating the presence of the seed of Crosby, so as to allow for one to verify the seed is between the minor surface area portions of the paper product without damaging the paper product.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baumli as applied to claim 10 above, and further in view of U.S. Patent No. 4,838,580 to Tuhkanen or U.S. Patent No. 5,158,809 to Proctor or WO Patent No. 94/00975 to Poret. Baumli does not disclose the major opposing surface area portion provides means for defining an address field. Tuhkanen, Proctor and Poret do disclose the major opposing surface area portion – 6f of Tuhkanen, - 13 of Proctor and – 16 of Poret provides means for defining an address field– see for example figures 1-8 and column 2 lines 60-65 of Tuhkanen, figures 1-2 of Proctor and figure 1 of Pore. Therefore it would have been obvious to one of ordinary skill in the art to take the paper product of Baumli and add the major surface areas with address field of Tuhkanen, Proctor or Poret, so as to make the paper product more user friendly since the address field won't be interfered with as the seed grows into a plant, thus allowing the user to be able to read the address field at all times.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baumli as applied to claim 10 above, and further in view of U.S. Patent No. 4,418,497 to Mastriano or U.S. Patent No. 5,062,229 to Werjefelt. Mastriano and Werjefelt do disclose the major opposing surface area portion provides means for defining an inscription field – 36 of Werjefelt and – 14 of Mastriano. Therefore it would have been obvious to one of ordinary skill in the art to take the paper product of Baumli and further add the means for defining an inscription field of Mastriano

Art Unit: 3643

or Werjefelt, so as to make the paper product more visually pleasing in that inscriptions can be placed onto the paper product.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baumli as applied to claim 10 above, and further in view of U.S. Patent No. 5,062,229 to Werjefelt. Baumli does not disclose the major opposing surface area portion provides means for defining a calendar field. Werjefelt does disclose the major opposing surface area portion provides means for defining a calendar field – 30 – see for example figures 1-5. Therefore it would have been obvious to one of ordinary skill in the art to take the paper product of Baumli and add the major surface area portion providing means for defining a calendar field of Werjefelt, so as to allow for the paper product to not be wasted and immediately discarded in that the calendar can be used throughout the year.

Claims 28-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baumli in view of Werjefelt.

Referring to claim 28, Baumli discloses a paper product comprising first and second paper sheets each having first and second opposite paper surfaces with the first paper surfaces being in substantially planar contiguous surface-to-surface opposing relationship at both major – 6 and minor – 1 opposing surface area portions thereof, the major – 6 and minor – 1 opposing surface area portions of the first and second paper sheets first paper surfaces of each pair being substantially permanently adhesively bonded to each other, a line of perforations – 3 in the first and second paper sheets which is adapted to be torn to facilitate the separation of the major – 6 and minor – 1 opposing surface area portions from each other, the major opposing surface area portions being devoid of germination seeds therebetween, and a germinative seed – S housed

Art Unit: 3643

between the minor – 1 opposing surface area portions of each pair which minor opposing surface area portions and the germinative seed housed therein can be entirely bodily removed as a plantable unit from the major opposing surface area portions along the lines of perforations for subsequent planting absent adversely affecting, damaging or destroying the major opposing surface area portions – see for example figures 1-4 and columns 1-3.

Baumli does not disclose a plurality of pairs of first and second paper sheets. Werjefelt does disclose a plurality of pairs of first and second paper sheets – 24 and 26 – see for example figures 1-2. Therefore it would have been obvious to one of ordinary skill in the art to take the paper product of Baumli and add the plurality of pairs of paper sheets of Werjefelt, so as to allow for the device to be more efficient and cost effective in that multiple quantities of seeds to be transported and subsequently planted by the user.

Baumli further does not disclose a means for connecting the pairs of paper sheets together. Werjefelt does disclose a means – 5,6,7 for connecting the pairs of paper sheets – 24 and 26 together – see for example figures 1-2. Therefore it would have been obvious to one of ordinary skill in the art to take the paper product of Baumli and add the means for connecting the pairs of sheets together of Werjefelt, so as to allow one to carry the plurality of sheets together as a whole without damaging or losing any of the sheets.

Referring to claim 29, Baumli as modified by Werjefelt further discloses the connecting means – 5,6,7 are located along a common edge of the pairs – 24 and 26 – see for example figures 1-2 of Werjefelt. Therefore it would have been obvious to one of ordinary skill in the art to take the paper product of Baumli as modified by Werjefelt and further add the connecting means located along a common edge of the pairs of Werjefelt, so as to allow for the paper

Art Unit: 3643

product to be easily manufactured in that the connecting means are located on only one edge of the paper product.

Referring to claim 30, Baumli as modified by Werjefelt further discloses each of the pairs – 24 and 26 defines a calendar field – 30 – see figures 1-2 of Werjefelt. Therefore it would have been obvious to one of ordinary skill in the art to take the paper product of Baumli as modified by Werjefelt and add the pairs defining a calendar field of Werjefelt, so as to allow for the paper product to not be wasted and immediately discarded in that the calendar can be used throughout the year.

Referring to claim 31, Baumli as modified by Werjefelt further discloses each of the pairs defines a calendar field – 24 and a post card field – 26 set-off by each line of perforations – 22 – see for example figures 1-2 and column 3 lines 25-50 of Werjefelt. Therefore it would have been obvious to one of ordinary skill in the art to take the paper product of Baumli as modified by Werjefelt and add the pairs defining a calendar field and a post card field of Werjefelt, so as to allow for the paper product to be flexible in that it has many uses.

Referring to claim 32, Baumli as modified by Werjefelt further discloses each line of perforations – 22 extends substantially between opposite edges of each of the pairs – 24 and 26 – see for example figures 1-2 of Werjefelt. Therefore it would have been obvious to one of ordinary skill in the art to take the paper product of Baumli as modified by Werjefelt and add the line of perforations extending between opposite edges of the pairs of Werjefelt, so as to allow for the perforated portion to be quickly torn and removed since the line of perforations extends between two opposite edges of the paper product.

Response to Arguments

5. Regarding claims 10 and 28, the claim as written states the "...minor opposing surface area portions and the germinative seed housed therein can be subsequently planted..." The claim does not state that the minor surface area portions are definitively planted with the seeds but only that they can be planted which means that the minor surface area portions as claimed do not have to be planted with the seeds. Further the Baumli reference states that the seed packet can be planted into the ground along with the seeds and thus the minor opposing surface area portions can be planted since they are part of the seed packet.

Regarding claim 16, the Baumli does disclose the minor opposing surface areas – at 1 are adhesively bonded to each other in that it is inherent that seed packets adhesively bond opposing surface areas together to form the enclosed pouch to store the seeds and the seeds could not be securely held inside the seed packet if the opposing surface areas were not adhered to each other in some way.

Regarding claims 28-32, as stated above the Baumli and Werjefelt reference are analogous and as further stated above it would be obvious to take the Baumli device and have multiple paper products connected together, so as to allow for more seeds to be transported and subsequently planted by the user thus making the device more efficient.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the

Art Unit: 3643

applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the teaching, suggestion or motivation to combine the Baumli and Werjefelt references is found in the knowledge generally available to one of ordinary skill in the art. Attaching multiple paper products together allows for easier transporting of the product in higher quantities.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

Art Unit: 3643

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

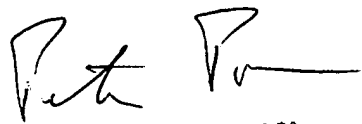
7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patent is cited to further show the state of the art with respect to seed enclosing paper products in general:

JP Pat. No. 1-171403 – shows seeds in paper product with perforations

8. Any inquiry concerning this communication from the examiner should be directed to David Parsley whose telephone number is (703) 306-0552. The examiner can normally be reached on Monday-Friday from 7:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Poon, can be reached at (703) 308-2574.


PETER M. POON
SUPERVISOR, PATENT EXAMINER
ART UNIT 3643